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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,979	01/22/2004	George Hradil	81394-499	7882

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EXAMINER	
WONG, EDNA	

ART UNIT	PAPER NUMBER
1753	

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/763,979	HRADIL, GEORGE	
	Examiner	Art Unit	
	Edna Wong	1753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 January 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

This is in response to the Amendment dated January 9, 2006. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

Specification

I. The abstract of the disclosure has been objected to because the abstract exceeds 150 words in length.

The objection of the abstract of the disclosure has been withdrawn in view of Applicant's amendment.

II. The disclosure has been objected to because of minor informalities.

The objection of the disclosure has been withdrawn in view of Applicant's amendment.

Claim Rejections - 35 USC § 112

Claims **1-20** have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection of claims 1-20 under 35 U.S.C. 112, second paragraph, has been withdrawn in view of Applicant's amendment.

Claim Rejections - 35 USC § 103

I. Claims **1-12** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **JP 2-301588** ('588).

The rejection of claims 1-12 under 35 U.S.C. 103(a) as being unpatentable over JP 2-301588 ('588) is as applied in the Office Action November 9, 2005 and incorporated herein. The rejection has been maintained for the following reasons:

Applicant states that there is no way that a skilled artisan would be led to use this specific range, in particular since it has been found that the baths of the '588 reference were not stable at pHs below 6.

In response, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. V. Garlock, Inc.,* 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. Denied,* 469 U.S. 851 (1984). In addition, a known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use, see *In re Gurley,* 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). Further, a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments, see *Merck & Co. v. Biocraft Laboratories,* 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), *cert. denied,* 493 U.S. 975 (1989). See MPEP § 2141.02, MPEP 2145X.D.1 and MPEP § 2123.

JP '588 teaches that the best bath pH is at *pH 5~8* (page 4, lines 3-5). This range

overlaps with Applicant's claimed pH range of between *3.5 and 5.5*. The best bath pH of JP '588 would have led a skilled artisan to use values which are in Applicant's claimed pH range.

Applicant states that the '588 reference also fails to disclose or teach the importance of the claimed concentration ratio.

In response, the Applicant has a different reason for, or advantage resulting from doing what the prior art relied upon has suggested, it is noted that it is well settled that this is not demonstrative of nonobviousness. *In re Kronig* 190 USPQ 425, 428 (CCPA 1976); *In re Linter* 173 USPQ 560 (CCPA 1972); the prior art motivation or advantage may be different than that of Applicants while still supporting a conclusion of obviousness. *In re Wiseman* 201 USPQ 658 (CCPA 1979); *Ex parte Obiaya* 227 USPQ 58 (Bd. of App. 1985) and MPEP § 2144.

JP '588 teaches that the tin and lead ion concentration can be selected arbitrarily, normally in the range of 0.5~200 g/l, but preferably in the range of *1~100 g/l* (page 3, lines 5-6). The complexors addition quantity may vary but normally in the range of 3~800 g/l, and preferably in *40~400 g/l* (page 3, lines 12-13). The preferred ranges include ratios that overlap with Applicant's ratio of between about 2:1 and 9:1. The preferred ranges of metal ions and complexors would have led a skilled artisan to use values which are in Applicant's claimed ratio range.

Applicant states that even the cited examples of this reference are not relevant, since the complexing agent and tin ions are present at a relatively high concentration ratio of 10:1 to 20:1 (i.e., 100 g/l to 200g/l of complexing agent and 10 g/l of tin ions).

In response, the disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiment (MPEP § 2123).

Applicant states the applicant's oath/declaration attests to the deficiencies of the reference as well as to the distinctions defined by these claims to further support the patentability of the present claims which have been amended only for informalities rather than substance.

In response, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. V. Garlock, Inc.,* 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. Denied,* 469 U.S. 851 (1984). In addition, a known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use, see *In re Gurley,* 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). Further, a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments, see *Merck & Co. v. Biocraft Laboratories,* 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), *cert. denied,* 493 U.S. 975 (1989). See MPEP § 2141.02, MPEP

2145X.D.1 and MPEP § 2123.

Furthermore, a newly discovered property does not necessarily mean the product is unobvious, since this property may be inherent in the prior art. *In re Best* 195 USPQ 430; *In re Swinehart* 169 USPQ 226. MPEP § 2112(I).

Applicant states that the significance of the problem of agglomeration of parts during electroplating cannot be dismissed. The specification addresses this problem, but the applicant has also presented a technical paper at a conference in 2004 to present some of his findings as well as to explain how to resolve this problem. The technical paper supports the unexpected advantages of the claimed concentration ratio and pH range and further supports the patentability of the present claims.

In response, JP '588 teaches that the best bath pH is at pH 5~8 (page 4, lines 3-5); the tin and lead ion concentration can be selected arbitrarily, normally in the range of 0.5~200 g/l, but preferably in the range of 1~100 g/l (page 3, lines 5-6); and the complexors addition quantity may vary but normally in the range of 3~800 g/l, and preferably in 40~400 g/l (page 3, lines 12-13).

The composition of the solution, as presently claimed, was known as disclosed by JP '588 (MPEP § 2121.02). The unexpected advantages that Applicant argues appear to be recognized latent properties that does not render nonobvious an otherwise known invention (MPEP § 2145 (II)).

II. Claim **19** has been rejected under 35 U.S.C. 103(a) as being unpatentable over **JP 2-301588** ('588) as applied to claims 1-12 above.

The rejection of claim 19 under 35 U.S.C. 103(a) as being unpatentable over JP 2-301588 ('588) as applied to claims 1-12 above is as applied in the is as applied in the Office Action November 9, 2005 and incorporated herein. The rejection has been maintained for the reasons as recited above.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

III. Claims **13-18** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **JP 2-301588** ('588).

The rejection of claims 13-18 under 35 U.S.C. 103(a) as being unpatentable over JP 2-301588 ('588) is as applied in the is as applied in the Office Action November 9, 2005 and incorporated herein. The rejection has been maintained for the reasons as recited above.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

IV. Claim **20** has been rejected under 35 U.S.C. 103(a) as being unpatentable over **JP 2-301588** ('588) as applied to claims 13-18 above.

The rejection of claim 20 under 35 U.S.C. 103(a) as being unpatentable over JP

2-301588 ('588) as applied to claims 13-18 above is as applied in the is as applied in the Office Action November 9, 2005 and incorporated herein. The rejection has been maintained for the reasons as recited above.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (571) 272-1349. The examiner can normally be reached on Mon-Fri 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Edna Wong
Primary Examiner
Art Unit 1753

EW
February 20, 2006